

REMARKS

Claims 1-62 are pending in this application. Claims 1 and 30 are independent claims.

By this amendment, claims 1 and 30 are amended for clarity.

Entry of the amendment is proper under 37 CFR §1.116 since the amendment:

(a) places the application in condition for allowance (for reasons discussed herein); (b) do not raise new issue requiring further search and/or consideration (since the amendment amplify issues previously discussed throughout prosecution); (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and/or (e) places the application in better form for appeal, should an appeal be necessary. Entry of the amendment is thus respectfully requested.

Personal Interview

Applicant wishes to thank Examiners Y. Aggarwal and T. Ho for the courtesies extended to Applicant's representative, Carolyn Baumgardner, during the July 15, 2005 personal interview. During the interview, the differences between the claimed invention and the Tamura and Scott references were discussed. The substance of the personal interview is summarized in the following remarks.

Second Request for Copy of Initialed PTO-1449

Applicant again respectfully requests a copy of the initialed PTO-1449 submitted on July 12, 2001. A prior request was made in applicant's previous Reply.

In reviewing the application file, the undersigned has noted that the appropriate initialed Form PTO-1449 in response to the Information Disclosure Statement (IDS) filed on July 12, 2001 has not been received by Applicant. The Examiner is therefore requested to return a copy of the initialed Form PTO-1449 to the undersigned as soon as possible.

The Claims Define Patentable Subject Matter

Concerning pending claims 1-62, the final Office Action maintains the previous rejections and again makes the following rejections:

(1) claims 1-6, 14, 30-34 and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent No. 09-37125 to Tamura (hereafter Tamura) in view of U.S. Patent No. 6,545,687 to Scott et al. (hereafter Scott);

(2) claims 7-11, 35-37 and 39-43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tamura in view of Scott and further in view of U.S. Patent No. 6,784,925 to Tomat et al. (hereafter Tomat);

(3) claims 12 and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tamura in view of Scott and further in view of U.S. Patent No. 5,737,491 to Allen et al. (hereafter Allen);

(4) claims 13 and 45 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tamura in view of Scott and further in view of U.S. Patent No. 6,188,431 to Oie (hereafter Oie);

(5) claims 15-21, 29, 46-51 and 55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tamura in view of Scott and further in view of U.S. Publication No. 2002/0101440 to Niikawa et al. (hereafter Niikawa);

(6) claims 22-26, 52-54 and 56-60 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tamura in view of Scott and Niikawa and further in view of Tomat;

(7) claims 27 and 61 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tamura in view of Scott and Niikawa and further in view of Allen; and

(8) claims 28 and 62 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tamura in view of Scott and Niikawa and further in view of Oie.

The above-noted rejections are respectfully traversed.

In the final Office Action, although a plurality of references are still being applied in rejecting claims 1-62, it appears that the Examiner is mainly relying upon the combination of Tamura and Scott. As such, our comments will mainly be directed to these aforementioned two base references.

Applicant respectfully submits that the claimed invention is distinguishable from the combination of Tamura and Scott for at least the following reasons:

In response to our previous arguments, the Examiner merely states that Tamura discloses in paragraph 19, lines 8-12, “erasing the image data from the memory after transferring the main image data.” In addition, the Examiner concedes that: “Tamura does not teach that this main image data that is left as it is in the memory after the image is transferred can be reduced from of [sic] the main image data after the main image is deleted.” (see Office Action, page 2, paragraph 2).

However, in an attempt to correct the deficiencies of Tamura, the Examiner imports Scott. Specifically, the Examiner alleges that Scott “teaches storing compressed images in order to minimize the storage requirements because the memory is normally at premium.” (see Office Action, page 2).

As such it appears that the Examiner believes that the combination of Tamura and Scott would have stored compressed images of the main images instead of main images after the main images are deleted. Applicant respectfully disagrees with this reasoning.

In essence, the Examiner is associating Scott’s “thumbnail images” with the claimed “main image data.” However, applicant respectfully submits that Scott’s “thumbnail images” are distinguishable from the claimed “main image data”.

For example, in the present invention a camera 10 can capture the main image data and store it in a storage medium. A communication device transmits the main image data stored in the storage medium to an external apparatus. An information processing device deletes the main image data

stored in the storage medium after the communication device transmit it. The information processing device produces reduced image data of the main image data and preferably stores the reduced image data in the storage medium.

In contrast with the present invention, both Tamura and Scott (or any combination thereof, assuming these teachings may be combined, which applicant does not admit) fail to teach or suggest saving a different form of the “main image data” after it is transmitted and deleted.

For instance, Tamura merely discloses to either store the main image data “as is” after a transfer or Tamura deletes the main image data after a transfer. However, Tamura is completely silent about storing a “reduced form” of the main image data after the main image data is deleted. (see Tamura, paragraph [0021]). Once the main image data in Tamura is deleted, it is lost forever. Tamura fails to contemplate saving a different form of the image data after a deletion step. In fact, Tamura fails to teach or suggest any means for recovering deleted main image data.

In importing Scott, the Examiner alleges that Scott discloses that thumbnail images are stored instead of main images. Therefore, the Examiner believes that the combined teachings of Tamura and Scott would have made it obvious to one skilled in the art ... to store reduced image data in the storage medium after the main images are transmitted and deleted. The Examiner’s motivation for combining Tamura with Scott is in order to minimize the storage requirements because the memory is normally at premium. (see Office Action, pages 2-3, paragraph 2).

However, applicant respectfully submits that Scott fails to start with a “subject main image data.” Scott is only concerned with thumbnail images, not “subject main image data” as set forth in the claimed invention.

As noted above, Tamura is not at all concerned with changing the form of the “subject main image data”. Nor is Tamura concerned with keeping a different form of the “subject main image

data" after a deletion step. Tamura merely discloses keeping the main image data "as is" after a transfer step or deleting the main image data after a transfer step. (see Tamura, paragraphs [0019]-[0021]). Nothing more in the form of image data manipulation is contemplated by Tamura. Nor does Tamura disclose anything about preserving memory space.

Furthermore, both Tamura and Scott fail to teach or suggest all of the steps of:
transferring the main image data, deleting the main image data from memory, then preparing a reduced form of the main image data and storing it in the memory, as set forth in the claimed invention.

Even if Scott teaches thumbnail images, Scott says absolutely nothing at all about deleting subject main image data and producing reduced image data from a subject main image data . Scott is merely concerned with manipulating thumbnails (not manipulating subject main image data), i.e., by compressing and scaling existing thumbnails. In other words, Scott starts with "thumbnails", instead of "subject main image data."

Furthermore, Scott is not at all concerned with transmitting subject main image data, deleting such main image data after the transfer, then generating a reduced form of the image data, as set forth in the claimed invention. Furthermore, Scott fails to replace deleted subject main image data with thumbnails, because Scott starts with thumbnails (not main image data) and uses a thumbnail database to practice its compressing and scaling process. Again, Scott invention is based on existing thumbnails.

A review of Scott reveals that Scott merely takes the existing thumbnails and then encodes and scales them down, thereby generating reduced/compressed thumbnails at varying resolution or sizes. (see Scott, Abstract; col. 16, lines 7-36).

As such, Scott fails to generate a reduced form of “subject main image data” taken from a camera, for example, instead, Scott merely generates a reduced form of existing thumbnails. Scott’s process is only directed towards manipulating existing thumbnails, not reducing subject main image data.

As a result, applicant respectfully submits that the combination of Tamura and Scott fails to teach or suggest keeping a reduced image data of the main image data stored in the storage medium after the main image data is deleted.

Furthermore, because Scott is only concerned with thumbnail manipulations and fails to address subject main image data, applicant submits that not only does the combination of Tamura and Scott fails to teach or suggest each and every feature as set forth in independent claims 1 and 30, but applicant also submits that the Examiner has failed to provide proper motivation for combining Tamura and Scott.

For example, applicant submits that one skilled in the art would not have been motivated to combine the thumbnail manipulating process of the secondary reference, Scott, with the electronic camera process of Tamura because Tamura is not at all concerned with thumbnails or thumbnail manipulations. As conceded by the Examiner, Tamura fails to disclose any type of reduced image or thumbnails.

Applicant further submits that but for our own disclosure of the specific elements/steps involved, i.e., their sizing, their storage, and their interrelationship with one another, the applied references themselves would not have instructed one versed in the art on how to go about selectively reworking and modifying the photographing process of Tamura to yield our claimed image transmitting device.

Accordingly, applicant submits that the Examiner's rejection is predicated upon impermissible hindsight, and not upon a suggestion from the combination of the references applied that would have been derivable by one versed in the art from the references themselves.

For at least the reasons noted above, applicant submits that the Examiner is improperly combining Tamura and Scott and has even failed to capture the gist of the claimed invention in such a combination of references.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that not only does the combination of Tamura and Scott fails to teach or suggest each and every feature as set forth in independent claims 1 and 30 as noted above, but the Examiner has also failed to provide proper motivation for combining Tamura and Scott.

Applicant respectfully submits that but for applicant's own disclosure of the specific features involved, i.e., the data form, and the storage thereof after specific steps, the applied references themselves would not have instructed one versed in the art on how to go about selectively reworking and modifying Tamura's device/process to yield applicant's claimed invention.

Accordingly, applicant submits that the Examiner's 103(a) rejection is predicated upon impermissible hindsight, and not upon a suggestion from the combination of the references applied that would have been derivable by one versed in the art from the references themselves.

In addition, applicant submits that the Office Action has improperly used applicant's invention as a road map to pick and choose features and paste the chosen features together to arrive at the claimed invention, even though the cited references do not provide any teachings, suggestion or motivation to make the modification.

Applicant respectfully submits that the combination of Tamura and Scott fail to teach or suggest each and every feature as set forth in the claimed invention.

Applicants respectfully submit that independent claims 1 and 30 are allowable over the combination of Tamura and Scott for at least the reasons noted above.

Furthermore, applicant respectfully submits that Tomat, Allen, Oie, and Niikawa all fail to make up for the deficiencies found in the combination of Tamura and Scott noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1-62 under 35 U.S.C. §103(a) is respectfully requested.

Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

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Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 **to schedule a Personal Interview.**

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

Respectfully submitted,

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